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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 724,928	11 28 2000	Stephen P.A. Fodor	018547036750	9541

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TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MARSCHER, ARDIN II

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 01 10 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,928

Applicant(s)

FODOR ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 57-155 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 57-155 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 57-155 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 26 sheets
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Detailed Action

Applicants' election with traverse of Specie I (array scanning wherein sample or target molecules have been applied to the array for binding reaction detection) and Specie A (scanning is performed with instructions for array holder and/or array movement) in Paper No. 15, filed 9/9/02, is acknowledged. The traversal is on the ground(s) that applicants argue that it is not apparent how the election materially changes the nature of the search conducted so as to create an undue burden and that the species are not mutually exclusive as the array and scanner can be moved in the same apparatus. This is not found persuasive because of reasons set forth in the previous office action wherein distinct practices were summarized for the separate species of the specie election which would require different search parameters as they would not and cannot be described as the same embodiment. Also, although applicants allege that the array and scanner can be moved in the same apparatus this statement still acknowledges the movement of at least either the array or scanner as are delineated as species of the instant invention. Also, none of the instant claims separate and/or distinctly claimed a practice where both the array and scanner are moved.

The requirement is still deemed proper and is therefore made FINAL.

Vagueness and Indefiniteness

Claims 57-155 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In lines 1-2 of claim 57 the computer readable medium comprising instructions is directed to performing a method for controlling an array scanner. This implies that the instructions should have some specificity for array scanning rather than being a general scanner of a generic surface. In contrast the medium comprises three elements, none of which require any array scanning specificity. The scanning of lines 3-4 of claim 57 indicate the scanning of an area of a substrate which apparently is an array of polymers but it is noted that the instructions only perform scanning controlling and do not describe any aspect of the instructions per se which differ from instructions which would scan a generic area of a surface. This concern is also present for the "receiving" of line 5 and the "outputting" of line 6 of the claim. It is well known that a scanner most commonly performs scanning, receiving data, and outputting the pixel data under control instructions without limiting what is being scanned or the information obtained during said scan. Thus, a generic scanner controller seems to be included in the practice of the instructions per se in the limitations of lines 3-6 of claim 57. That is, scanner control methods or instructions are independent from what is being scanned. Clarification of the metes and bounds of claim 57 is requested via clearer claim wording as to whether there is some array scanning specificity in the executable instructions stored on the medium as in the preamble of the claim or whether generic scanner control instructions would accomplish the steps in lines 3-6 of claim 57 as apparently they would. The unclarity is also present in independent claims 65, 73, 78, 86, 94, 102, 108, 120, 132, and 144. Claims dependent either directly or indirectly from claims 57, 65, 73, 78, 86, 94, 102, 108, 120, 132, and 144 are included in this rejection due to their dependence.

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Claims 82-85 are vague and indefinite as to what is being claimed due to depending from canceled claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 57-155 are rejected under 35 U.S.C. 102(b) and (e)(2) as being clearly anticipated by either of Kamentsky et al.(P/N 5,427,910) or Hubbell et al.(P/N 5,571,639).

Both Kamentsky et al. and Hubbell et al. perform scanning of an area of a surface, retrieve pixel data, and output them to image files under computer control which includes a computer medium upon which executable control instructions are located. Kamentsky et al. characterizes chromosomes on a sample slide as shown in Figure 1 wherein the slide is located on a stage, item # 18, in Figure 1. The scanning invention is summarized in the section of the SUMMARY OF THE INVENTION in columns 2-6. The computer controlled stepper motor controlled stage, item # 18, is described in column 6, lines 26-38, and column 7, lines 50-67. At the bottom of column 6, lines 66-68, the scanning spot size is disclosed as approximately 2 microns which

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clearly discloses the scanning capability as required in the instant claims which would be a 4 square micron area which includes locations smaller than 250000 square microns such as required in instant claim 57. The scanned information in pixels is received from the scanner and stored as an image data file for manipulation as described in column 11, line 54, through column 16, line 64. Similarly, Hubbell et al. discloses the computer instructed scanning, with medium therefore, of an array with pixel data retrieval, and image storing in column 18, line 15, through column 19, line 14. In column 19, lines 6-11, Hubbell et al. discloses the moving of the horizontal stage for scanning practice.

No claim is allowed.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

January 9, 2003


ARDIN H. MARSCHEL
PH.D.